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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,169

12/01/2006

Christoph Binkert

A0345.0025

3809

32172

7590

10/18/2007

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,169	Applicant(s) BINKERT ET AL.	
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 11-35, 40 and 45-56 is/are pending in the application.
- 4a) Of the above claim(s) 13-17 and 47-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 11, 12, 18-35, 40, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/17/2006</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1, 2, 11-35, 40 and 45-56 are pending in the application.

Election/Restrictions

Applicant's election without traverse of Group II {claims 1, 2, 11, 12, 18-35, 40, 45 and 46 (all in-part) - drawn to products of formula I wherein R^3 is $-O-CR^7R^8-CR^9R^{10}-(CR^{11}R^{12})_n-O-R^{13}$ } in the reply filed on August 8, 2007 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

Claims 13-17 and 47-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention(s), there being no

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allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 8, 2007.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statement filed on October 17, 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 11, 12, 18-35, 40, 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2 of claim, the word "General" should be deleted since its use implies compounds not embraced by Formula (I).

In claim 1, under the definition of R^1 , an "or" should be added before the last substituent listed for proper Markush language format.

In claim 1, under the definition of R^2 , an "or" should be added before the last substituent listed for proper Markush language format.

In claim 1, under the definition of R^3 , an "or" should be added before the last substituent listed for proper Markush language format.

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In claim 1, under the definition of R^4 , an "or" should be added before the last substituent listed for proper Markush language format.

In claim 1, it is unclear what Applicant intends by the expressions "solvent complexes" and "morphological forms" and therefore, the claims metes and bounds cannot be ascertained. It is suggested that these expressions be deleted from the claim.

In claim 18, line 2 of claim, the word "General" should be deleted since its use implies compounds not embraced by Formula (II).

In claim 18, under the definition of R^{14} , an "or" should be added before the last substituent listed for proper Markush language format.

In claim 18, under the definition of R^{15} , an "or" should be added before the last substituent listed for proper Markush language format.

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In claim 18, under the definition of R^3 , an "or" should be added before the last substituent listed for proper Markush language format.

In claim 18, under the definition of R^4 , an "or" should be added before the last substituent listed for proper Markush language format.

In claim 20, an "or" is needed after "unsubstituted".

In claim 21, an "or" is needed after "unsubstituted".

In claim 29, an "or" is needed after "unsubstituted" and an "and" is needed before " R^{15} ".

In claim 30, an "or" is needed after "unsubstituted" and an "and" is needed before " R^{17} ".

In claim 31, an "or" is needed after "unsubstituted".

In claim 32, an "or" is needed after "unsubstituted" and an "and" is needed before " R^{15} ".

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In claim 33, an "or" is needed after
"unsubstituted" and an "and" is needed before "R¹⁵".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a)
which forms the basis for all obviousness rejections
set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 18-35, 40, 45 and 46 are rejected
under 35 U.S.C. 103(a) as being unpatentable over Dong
et al. {US 2004/0009527}.

***Determination of the scope and content of the prior art (MPEP
§2141.01)***

Applicant claims thiazolidin-4-one compounds. Dong
et al. teach thiazolidin-4-one compounds that are
structurally similar to the instant claimed compounds.

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See entire disclosure in Dong et al.; particularly Formula II in paragraph [0017] on page 2; paragraph [0060] on page 6; paragraph [0099] on page 9; the next to the last structure in column 1 on page 32; and especially, the first compound listed in the variable defined table in column 2 on page 32.

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

The difference between the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP

§2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar

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compounds would possess similar activity (e.g., mimics for nicotinamide adenine dinucleotide (NAD)).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful as mimics for NAD. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

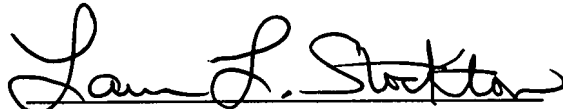
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for

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unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, reading "Laura L. Stockton". The signature is fluid and cursive, with the first name "Laura" and last name "Stockton" clearly distinguishable.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

October 15, 2007